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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/622,296	03/25/96	KELLER J	KELL-24.487

EXAMINER	
FLINK, S	
ART UNIT	**PAPER NUMBER**
3307	3

F3M1/0225

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DATE MAILED: 02/25/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) 6 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-5+7-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☑ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☑ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☑ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☑ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

– SEE OFFICE ACTION ON THE FOLLOWING PAGES –

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1 - 5 and 7 - 17, drawn to a dampening apparatus and method of making, classified in Class 101, subclass 148.

II. Claim 6, drawn to an oscillating roller, classified in Class 101, subclass 348.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the oscillating roller could employ an internal oscillating mechanism. The subcombination has separate utility such as an oscillating roller in an ink roller train.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as recognized by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with John Montgomery on 2/4/97 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 -

5 and 7 - 17. Affirmation of this election must be made by applicant in responding to this Office action. Claim 6 is withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

The status of the parent applications listed on page 1 lines 5 - 10 should be updated and/or clarified. In particular, this application would appear to be *continuation*, not a divisional, of application Serial No. 08/303,868 since it claims the same invention. Applicant should note that a divisional or a continuation application must have the same disclosure as the original application. See M.P.E.P. § 201.06, § 201.06(a), and § 201.07.

The disclosure is objected to because of the following informalities: On page 13 line 20 it is not clear why "Lubricating" is capitalized. The sentence on page 15 line 14 appears to be incomplete. On page 15 line 15 "and", second occurrence, should be deleted. Appropriate correction is required.

The drawings are objected to because the arrow on the form roller (38) in Figure 1, presumably indicating nip pressure, does not have a reference numeral nor does it appear to be addressed in the specification. Correction is required.

Applicant is required to submit a proposed drawing correction in response to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification fails to provide an adequate written description of the invention. In Figure 1 reference numerals (54), (56), (58) refer to nip pressures between the various cylinders in the dampening train. However, it is not clear if these reference numerals merely indicate the presence of nip pressure or indicate structure to adjust the nip pressure.

Claims 7 - 9 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 1 - 5 and 7 - 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 13 the recitation of the oscillating roller being "coupled to" the rotating plate cylinder renders the scope of the claim indefinite. Note that a rotating plate cylinder is only inferentially recited in the preamble. However, this recitation positively claims the oscillating roller in combination with the plate cylinder. It cannot be accurately determined if applicant intends to claim a subcombination of the oscillating roller or a combination of the oscillating roller and the plate cylinder.

Applicant is requested to state on the record the intended scope of the claim and amend the claim consistent with that intention. Also in line 13 "a gear mechanism" is only inferentially recited. In line 17 the recitation of the form roller "contacting" the plate cylinder renders the scope of the claim indefinite for the same reasons stated above.

In claim 3 "transfer roller" and "water form roller" lack proper antecedent bases. Note the specific terminology previously used in claim 1.

In claim 5 line 2 it is not clear what the gear drive is "operatively connected" to for providing the desired result.

In claim 7 line 13 "the predetermined hardness" lacks any clear antecedent basis. In line 19 "said rotation of said plate cylinder" lacks proper antecedent basis.

In claim 9 line 3 "having resilient compressibility characteristic of rubber having said hardness" is functional and repetitive.

In claim 10 line 4 the recitation of the oscillating roller being "gear driven" is functional without any positive recitation of structure to provide the function.

In claim 11 line 5 the recitation of the oscillating roller being "gear driven" is functional without any positive recitation of structure to provide the function.

In claims 12 and 16 "able" and in claims 13 and 17 "sufficiently porous" are functional without the clear recitation of structure to provide the desired capability. These claims should positively recite structural characteristics of the roller to provide

the recited properties.

In claim 14 line 15 "a gear mechanism" is only inferentially recited.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(o). Correction of the following is required: The "means for connection" to said lithographic printing press as recited in claim 14 line 5 does not appear to be specifically supported by the specification.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1, 3 - 5, 13, 14, and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over applicant's admission of prior art in view of Fadner et al. (US 5,107,762) and Shiba et al. (US 5,429,046). Applicant states on page 24 line 1 through page 5 line 3 in the specification that the particular sequence of the dampening rollers is known in the art. Note also the Jepson type preamble of claim

7 in parent application 08/303,868 which recites that the sequence of the rollers is known in the art. *In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).* The primary difference between the prior art and applicant's claimed invention is that the oscillating roller has an ink receptive, porous surface. Fadner et al. teach the desirability of providing all of the rollers in a dampening roller train with ink receptive surfaces to enhance the transfer of the dampening fluid to the plate cylinder. See the entire disclosure of Fadner et al., in particular, column 3 lines 11 - 17 and 8 lines 19 - 26. Shiba et al. teach the desirability of a dampening roller (1) having a compressible porous surface (12) so as to adequately transfer dampening fluid to a plate cylinder. It would have been obvious to one of ordinary skill in the art to provide the oscillating roller in a conventional dampening system with an ink receptive, porous surface in view of Fadner et al. and Shiba et al. so as to provide a thin, but adequate, supply of dampening fluid to the plate cylinder. With respect to claim 3 note that all of the rollers of Fadner et al. are ink receptive. With respect to claim 4 note the roller sequence disclosed in claim 7 of parent application Serial No. 08/303,868. With respect to claim 5 see column 3 line 64 through column 4 line 11 of Fadner et al. With respect to claims 13 and 17 insofar as applicant's porous surface absorbs fluids, so would the porous surface disclosed by Shiba et al.

Claims 2, 12, 15, and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over applicant's admission of prior art in view of Fadner et al. and Shiba

et al. as applied to the claims above, and further in view of Keller (US 4,949,637). Keller teaches that a rubber covered oscillating roller in a dampening train should be made of a relatively hard rubber. See column 4 lines 30 - 35 of Keller. While Keller does not specifically teach the durometer, it would have been readily apparent to one skilled in the art through obvious routine experimentation to arrive at the recited durometer range in view of the teachings of Keller. It would have been obvious to one of ordinary skill in the art to provide a conventional dampening system, as modified by Fadner et al. and Shiba et al., with an oscillating roller having between 95 - 100 durometer in view of Keller. With respect to claims 12 and 16 note the comments above with respect to claims 13 and 17.

Claims 10 and 11 are rejected under 35 U.S.C. § 103 as being unpatentable over applicant's admission of prior art in view of Fadner et al., Shiba et al., and Omori (US 4,524,690). The conventional dampening system, Fadner et al., and Shiba et al. have been addressed above. Omori teaches the conventionality of means for adjusting the pressure between each of the rollers in a dampening train. It would have been obvious to one of ordinary skill in the art to provide a conventional dampening train with an ink receptive, gear driven, oscillating roller in view of Fadner et al. and Shiba et al. so as to provide a thin, but adequate, supply of dampening fluid to the plate cylinder and to provide means for adjusting the pressure between the rollers in view of Omori so as to adjust and accurately meter the dampening fluid. Additionally, it

would have been obvious to one of ordinary skill in the art to modify an existing press in view of the teachings of Fadner et al. and Omori.

Claims 7 - 9 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the porous roller (31) of Niemiro et al. and porous roller (12) of Dahlgren.

Claims 1 - 5 and 10 - 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 4 of U.S. Patent No. 5,540,145. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are fully encompassed by the structure recited in the patented claims.

Claims 1 - 5 and 7 - 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 5 and 7 - 18 of copending application Serial No. 08/747,272. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are fully encompassed by the structure recited in the patented claims.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of

the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk at telephone number (703) 308-0982.

The Supervisory Primary Examiner for Art Unit 3307 is Edgar Burr whose telephone number is (703) 308-0979. The fax number for Art Unit 3307 is (703) 308-2864.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0858. The fax phone number for the Group is (703) 305-3590.

Stephen Funk
February 24, 1997

STEPHEN R. FUNK
PRIMARY EXAMINER
GROUP 3300